

## REMARKS

Claims 6 and 8-23 are pending in the above-captioned application for examination. Claims 3 and 12 presently stand rejected under 35 U.S.C. §112, claims 1-6, 10-12, 16, and 20 presently stand rejected under 35 U.S.C. §102, and claims 7-9, 13-15, and 17-19 presently stand rejected under 35 U.S.C. §103. Based on the foregoing amendments, and the following remarks, Applicants hereby request reconsideration and allowance of claims pending in the application including new claims 21-23.

A certified copy of the EP application will be provided.

## **I. Amendment to the Claims**

Applicants initially note that claims 6, 8-9, 12-13, and 16-17 have been amended while claims 1-5 and 7 have been canceled. Support for these amendments may be found throughout the application and, in particular, on page 3, lines 1-27 and page 5, lines 1-10 and line 27.

## II. Claim Rejections Under 35 U.S.C. §112, Second Paragraph

In the Office Action, claims 3 and 12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection to claim 3 has been obviated as this amendment cancels claim 3. Claim 12 stands rejected as being indefinite and needing clarification for failing to provide further detail as to size of the cup and orifice as well as proper units for the viscosity measurement. (See Office Action, page 3, paragraph number 6.) Claim 12 has been amended to include proper viscosity units of “seconds” which is a measurement of the flow time. The size of the cup and orifice used for the viscosity measurements are known in the art to be

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chosen according to the viscosity range for the application, which is clearly stated by Applicants as being within the viscosity range of 39-42 seconds, on page 3, lines 25-27 of Applicants' application, or at least 39 seconds, in amended claim 12. Cup orifice sizes are chosen to provide efflux times within the seconds range of the viscosity and are defined by these flow times. Therefore, it is not indefinite if cup and orifice sizes are not specifically stated since the sizes are defined and chosen by the viscosity flow time, which is stated in amended claim 12.

### *III. Claim Rejections Under 35 U.S.C. §102*

In the Office Action, claims 1-6, 10-12, 16, and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,629,628 issued to Negro (hereinafter "Negro"). Applicants have canceled claims 1-5, therefore, the rejection stands against the remaining claims 6, 10-12, 16, and 20. Applicants respectfully traverse the rejections under 35 U.S.C. §102 because the cited reference does not disclose each and every limitation of the rejected claims, as written or amended.

More particularly, the cited reference does not describe or suggest a wafer batter recipe containing cocoa powder from 2 to 10% by weight, among other ingredients, as called for in amended claims 6 and 16. Rather, Negro discloses three wafer batter recipes containing numerous ingredients, none of which contains cocoa powder, and one example which shows using 1.5% cocoa powder. Negro shows using 1.5% cocoa powder in the wafer batter to add color to the wafers; Applicants teach using 2 to 10% cocoa powder for improving the crispy texture of the wafer. Therefore, Negro does not describe or suggest the invention as claimed in amended claims 6 or 16.

Although Negro also discloses coating wafers in chocolate and including a cream filling in between the wafers as do dependent claims 10, 11, and 20, Negro is

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missing the further requirement of independent claims 6 and 16, from which claims 10-11 and 20 depend therefrom. The independent claims add the requirement of making wafers according to Applicants' batter recipe containing from 2 to 10% cocoa powder, among other ingredients. Therefore, since Negro does not disclose the addition of 2-10% cocoa powder, claims 10-11 and 20 are also allowable for the reasons discussed above with respect to amended claims 6 and 16.

Negro does not describe or suggest a viscosity value similar to Applicants' viscosity value for its batter recipe, as called for in amended claim 12. Rather Negro does not describe any viscosity values at all, and instead indicates that to avoid a cake-like wafer too much oil should be avoided, and to avoid a sticky wafer too little oil should be avoided (*See Negro col. 2, lines 43-46*). This is the only discussion that could be interpreted as relating to viscosity, and even that does not suggest a viscosity value let alone a value in the range disclosed by Applicants in amended claim 12. It is not inherent that Negro would have Applicants' viscosity range merely because Negro also makes wafers of a similar thickness, especially since Negro's batter is made up differently with numerous additional ingredients and even with differing amounts of the same ingredients (*See Negro Recipes I-III*). Furthermore, it cannot be assumed that just because a similar thickness wafer is obtained, that the batter must have had the same viscosity. Negro even states at column 1, lines 38-46, that "to make the wafer thicker ... it is necessary to increase the surface area of the product to be baked" by baking the wafer in a "wafer mould with indentations;" there is no mention of having to achieve a certain viscosity value similar to Applicants' in order to obtain this thickness.

Amended claim 12 also further describes the cocoa powder range of 2 to 10%, whereas Negro does not (as discussed above in regards to claims 6 and 16). Therefore,

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Negro does not describe or suggest the invention as claimed in amended claim 12. Thus, Applicants respectfully submit that the cited reference does not describe or suggest the invention as claimed in claims 6, 10-12, 16, and 20 and reconsideration and allowance of these claims is hereby requested.

**IV. *Claim Rejections Under 35 U.S.C. §103***

Claims 7-9, 13-15, and 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Negro as applied to the claims above under the 35 U.S.C. §102(b) rejections in view of Technology of Biscuits, Crackers and Cookies (hereinafter "Technology Reference"), and Dictionary of Food Ingredients (hereinafter "Dictionary"), and further in view of Biscuit, Cracker and Cookie Recipes for the Food Industry (hereinafter "Recipe Reference"). Claim 7 has been canceled and will not be discussed further. Claims 8-9, 14-15, and 18-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Negro in view of the above stated references and further in view of U.S. Patent No. 5,258,199 issued to Moore, and further in view of U.S. Patent No. 4,396,633 issued to Tresser. Applicants respectfully traverse these rejections because there are no motivations to combine these references.

**A. *Claims 8-9, 13-15, and 17-19***

The Office Action states, at page 5, paragraph number 15, that in regards to claims 8-9, 13-15, and 17-19, Negro teaches wafers with all the ingredients recited by Applicants in claims 13 and 17. However, Negro does not describe wafers with the ingredient ranges as recited by Applicants in amended claims 13 and 17, nor is there any suggestion of similar ranges in the other references. The Dictionary does not disclose ranges for wafer ingredients, and both the Recipe Reference and the

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Technology Reference disclose cocoa, lecithin, and salt in different ranges than Applicants'.

Furthermore, independent claims 6, 12 and 16, from which the rejected claims depend therefrom, claim 2 to 10% cocoa powder. The Dictionary does not provide any recommended usage amounts for cocoa in a wafer recipe, it merely offers a general definition of cocoa. The Recipe Reference does not describe cocoa amounts in Applicants' range, it shows about 0.26% cocoa (nor lecithin, salt or oil in Applicants' range, for that matter), and neither does the Technology Reference, disclosing only about 0.3% cocoa (it also does not describe lecithin, sodium bicarbonate, or salt in Applicants' range). It is not obvious to combine any of the three given references with Negro to obtain Applicants' cocoa range and therefore the independent claims are not obvious, and as a result dependent claims 8-9, 13-15 and 17-19, that depend therefrom, are also not obvious.

Examiner states in the Office Action, at page 6, paragraph number 15, that Negro teaches 0.6% bicarbonate in Recipe II, at column 2, lines 55-67, which falls within Applicants' range, however, that is not correct; Applicants' range of sodium bicarbonate is from 0.05-0.07%. Furthermore, Applicants describe the use of sodium bicarbonate, not bicarbonate, and this is reflected in amended claims 6 and 17. As a result the amounts of both sodium bicarbonate and salt of hartshorn should not be combined when calculating final percentage amounts since salt of hartshorn is ammonium carbonate. Therefore, if the percent sodium bicarbonate is recalculated for Negro Recipe II using only sodium bicarbonate, it is about 0.055%, which does fall in Applicants' range, however, Recipe II is for a non-cocoa batter recipe and there is nothing to describe or suggest applying this same range of sodium bicarbonate to a cocoa batter. The one batter example in Negro that does contain cocoa describes using

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0.04% sodium bicarbonate (not 0.8% as examiner states in Office Action at page 6, paragraph no. 15) which is below Applicants' range. The different amounts of sodium bicarbonate in Negro cannot be combined into a range to cover from 0.04% to 0.055%, for example, encompassing both values and applicable to both cocoa and non-cocoa batter recipes because there is nothing described in the Negro reference or in the other three references to suggest doing so.

Next, Negro does not teach lecithin in Applicants' range of 0.2 to 0.3%. Negro teaches amounts of about 0.15 to 0.16%. Furthermore, the dictionary definition of lecithin found in the Dictionary of Food Ingredients may give a usage range of 0.1 to 1% of lecithin, but does not imply that this range is applicable to wafer products. There is no motivation to combine a broad lecithin usage range for food products in general with the range disclosed in Negro for wafers to obtain Applicants' range of lecithin.

Negro's salt range (0.1% for cocoa batter, and 0.08 to 0.1% for a non-cocoa batter) does not fall within Applicants' range for salt of 0.6-0.9%, nor do any of the references offer any motivation to increase the amount of salt to Applicants' range. The Technology Reference may discuss how salt is used for enhancing flavor but does not suggest using salt in any range. Furthermore, the Technology Reference only describes a salt range of about 0.07-0.30%. Negro also describes other ingredients for enhancing flavor without any suggestion that these amounts are variable except within the given ranges. Therefore, there is no suggestion in the references to make the salt range given in Negro variable outside of the given range in the patent in order to be within Applicants' range.

Finally, Negro describes two low percentages of oil in batter recipes without cocoa, 0.32% and 0.2%, while describing an altogether different amount of oil when used in a cocoa batter of about 2.4%; all of which do not fall within Applicants' range of

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1.5-1.8% oil. There is nothing to suggest in any of the references that the oil amounts in Negro can be combined together into a range applicable to both cocoa and non-cocoa batters that would span Applicants' range. Therefore, the oil ranges of Negro still fall outside of Applicants' range.

Furthermore, Applicants respectfully note that the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Rouffet*, 47 USPQ2D 1453, 1457-58 (Fed.Cir. 1998). In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See MPEP §§706.02(j) and 2143-2143.03).

The rejection of Claims 8-9, 13-15, and 17-19 does not set forth how each of these criteria are met. There is no motivation found in any of the references to apply the cocoa powder range used in Applicants' batter recipe to Negro nor to increase the lecithin amount, the salt amount, or the oil amounts used in Negro to that of the ranges given in Applicants' batter recipe. Therefore, for at least these reasons, Applicants respectfully submit that Negro in view of Technology of Biscuits, Crackers and Cookies, in view of Dictionary of Food Ingredients, and further in view of Biscuit, Cracker and Cookie Recipes for the Food Industry do not disclose or suggest the invention claimed in claims 8-9, 13-15, and 17-19 and reconsideration and allowance of these claims is hereby requested.

#### **B. Claims 8-9, 14-15, and 18-19**

Additionally, the Office Action states that in regards to claims 8-9, 14-15, and 18-19 these are further rejected in view of the above references mentioned in section A,

and further in view of Moore. Negro shows an example of a wafer batter recipe with 1.5% cocoa powder; Moore teaches a chocolate-flavored confection or morsel, such as a chocolate chip, which may contain anywhere from 1-10% defatted cocoa (where defatted means 99% fat free, *see* Moore col. 12, lines 10-13) and is made up primarily of sugars and sugar alcohols. The chocolate morsel may then be added to other confections or baked goods. The Moore reference describes a compound primarily made up of sugars and is a completely different technology utilizing cocoa powder than Negro's wafer recipe, and there is no motivation to combine the one reference using defatted cocoa powder in morsels with Negro to yield a cocoa powder range similar to Applicants' range.

Next, claims 8-9, 14-15, and 18-19 are also rejected further in view of Tresser, in addition to the above references in section A, where Tresser is also a different technology from Negro's wafer technology and lacks any motivation to combine. Tresser's confectionery coating composition, such as a chocolate coating for ice cream, may also contain cocoa powder, however, the use of cocoa powder in this reference only describes its addition to the chocolate coating. The examiner points to column 10, lines 40-50 (Table in example 5) as disclosing cocoa powder for use in a wafer composition in the range of 5.1-16.3%, however, that is not correct; the table in example 5 discloses a recipe for the *coating* composition, and not for a wafer. (*See* Tresser, Column 10, lines 32-39: "The ... blends ... were used to make up confectionery coating compositions.... The compositions ... were of the following constituents:" which then goes on to list the Table in Example 5 as the constituents.) It is the coating composition that may contain cocoa powder in the range of 5.1-16.3%, and not a wafer. There is no motivation to combine a range of cocoa powder used in a coating composition for ice cream with a recipe for wafers.

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Furthermore, Applicants respectfully note that the Patent Office bears the burden of establishing a *prima facie* case of obviousness, as discussed above. *In re Rouffet*, 47 USPQ2D 1453, 1457-58 (Fed. Cir. 1998).

Therefore, for at least these reasons, Applicants respectfully submit that Negro in view of the Section A references and further in view of Moore and Tresser do not describe or suggest the invention claimed in claims 8-9, 13-15, and 17-19, and reconsideration and allowance of these claims is hereby requested.

V. *New Claims*

New claims 21-23 have been added. Applicants note that these claims are all dependent upon amended independent claim 6 and that claims 22 and 23 are similar to original claim 10, which both have been shown to be allowable over the cited references. Therefore, Applicants respectfully submit that these new claims are allowable over the cited references for reasons similar to those already presented for independent claim 6 and claim 10. Support for these claims may be found throughout the application and, in particular, on page 1, lines 31-35, page 2, lines 18-37, page 4, lines 4-11, page 5, lines 35-41, and page 6, lines 1-9.

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### CONCLUSION

In view of the foregoing, Applicants submit that claims 6 and 8-23 are patentable over the cited references and hereby respectfully request reconsideration and allowance of claims 6 and 8-20 and allowance of new claims 22-23.

The Commissioner is hereby authorized to charge any additional fees which may be required in this matter, or to credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,  
FITCH, EVEN, TABIN & FLANNERY

Date: July 21, 2006



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